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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91190899
Party	Plaintiff Sharp Kabushiki Kaisha, a/t/a Sharp Corporation
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Submission	Motion to Amend Pleading/Amended Pleading
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Date	10/06/2011
Attachments	Motion for Leave.pdf (16 pages)(741983 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

SHARP KABUSHIKI KAISHA, a/t/a)	Attorney Ref.: 790-2052
SHARP CORPORATION,)	
)	
Opposer,)	
)	
v.)	Opposition No. 91190899
)	Mark: ONSHARP
ONSHARP, INC.,)	Application No. 77/645,273
)	
Applicant.)	

OPPOSER’S MOTION FOR LEAVE TO AMEND NOTICE OF OPPOSITION

Opposer, Sharp Kabushiki Kaisha, a/t/a Sharp Corporation, respectfully moves the Board, under Federal Rules of Civil Procedure 15(a), and TBMP §507.01, for leave to amend its Notice of Opposition, primarily to add clarity to its dilution claim to specify that its marks were famous before the alleged date of first use by Applicant; and to assert additional registrations in support of its Likelihood of Confusion and Dilution claims. A signed copy of the [Proposed] Amended Notice of Opposition is attached hereto as Exhibit “A.”

Defendant will have sufficient opportunity to thoroughly investigate these allegations since the parties are still in the process of fully responding to each other’s initial discovery requests. Further, on August 26, 2011, Opposer filed a motion to extend the discovery period and the subsequent trial dates by 90 days. On September 27, 2011, the Board granted this motion. Thus, Opposer’s trial period is not scheduled to open until February 2, 2012, at the earliest. Therefore Applicant would not be

prejudiced in any cognizable way by Opposer's proposed amended Notice of Opposition.

Opposer made a good faith effort to resolve the issues identified in this motion by correspondence. On September 29, 2011, Opposer's undersigned counsel e-mailed a copy of Opposer's proposed amendment to the notice of opposition seeking a stipulation for Applicant to agree to the filing of the same by October 5, 2011. However, opposing counsel did not respond, thereby necessitating this motion.

The reasons for Opposer's motion for leave to amend its Notice of Opposition are further set forth below.

I. Procedural Background

Opposer, in its notice of opposition filed on July 6, 2009, asserts that it has priority and there would be a likelihood of confusion and dilution of its asserted marks if Applicant's Application No. 77/645,273 for the mark ONSHARP is permitted to register. On February 3, 2011, (after several consented extensions) Applicant filed its Answer to the Notice of Opposition and affirmative defenses.

On April 7, 2011, Applicant served written discovery requests on Opposer. On June 13, 2011, Opposer provided its objections and responses thereto. On June 15, 2011, Opposer served written discovery requests on Applicant. On August 3, 2011, Applicant provided its objections and responses thereto.

Based on Opposer's review of the initial, incomplete discovery responses of Applicant, Opposer realized that additional registrations that had not been expressly asserted were applicable to support its allegations of a likelihood of confusion and dilution. In addition, Opposer determined that it should amplify its pleaded claim of

dilution to indicate that Opposer's SHARP marks were famous before any alleged use of the mark Onsharp by Applicant. It is believed that the proposed changes, which serve to amplify the allegations already included in Opposer's pleading, will not significantly alter the nature of the trial on the merits or any remaining discovery in this case.

The close of discovery per the original scheduling order was September 4, 2011. However, on August 26, 2011, Opposer filed a motion to extend the discovery period and the subsequent trial dates by 90 days because, in part, of Applicant's deficient discovery responses. That motion has been granted as conceded. The current due date for the close of discovery is now December 3, 2011.

II. Argument

Motions to amend pleadings in cases of oppositions are governed by Federal Rule of Civil Procedure 15. Trademark Rules 2.107 and 2.116(a). In general, pleadings in oppositions before the Board may be amended in the same manner and to the same extent as in a civil action in a United States district court. TBMP 507.01 (3d ed. 2011). Leave to amend is to be "freely given when justice so requires." Fed.R.Civ.P. 15(a)(2); TBMP 507.02 (3d ed. 2011). Motions to amend pleadings are liberally granted unless the amendment would violate settled law or be prejudicial to the rights of an adverse party. See *Hurley International LLC v. Volta*, 82 USPQ2d 1339, 1341 (TTAB 2007); *Commodore Electronics v. CBM Kabushiki Kaisha*, 26 USPQ2d 1503 (TTAB 1993); *Buffett v. Chi-Chi's, Inc.*, 226 USPQ 428 (TTAB 1985). In this case, the Applicant will not suffer any prejudice if the Board allows the proposed amendment.

(A) Opposer Has Good Cause for Proposing Its Amendment

In its initial Notice of Opposition, Opposer asserted its family of SHARP marks and several of its registrations that support its claims of likelihood of confusion and/or dilution. Upon further review, Opposer wishes to assert additional registrations in its pleading that support its claims of likelihood of confusion and/or dilution. In particular, it wishes to assert Registration No. 2765106 for the mark SHARP for “computer software for managing documents” and Registration No. 2756747 for the mark SHARPDESK for “computer software for managing documents.” The opposed application covers, *inter alia*, “design and development of on-line computer software systems”; “Design of . . . computer software and web sites”; and “IT consulting services.” The registrations proposed to be added cover goods that are highly related to the services in Applicant’s opposed application. The marks of the registrations proposed to be added are highly similar to the mark of Applicant’s proposed application. There are no limitations on the channels of goods or potential purchasers of the proposed registrations or Applicant’s services. For at least these reasons, Registrant believes that the additional registrations further support Opposer’s legal claims.

Applicant was given notice of these registrations in Opposer’s requests for admission of June 15, 2011. In Applicant’s response on August 3, 2011, Applicant objected to requests concerning those registrations on the basis that those registrations were not specifically asserted in the Notice of Opposition.

Further, for ease of proof and in view of *The Toro Co. v. ToroHead, Inc.*, 61 USPQ2d 1164, 1174, n. 9 (TTAB 2001), which requires that for dilution claims against use-based applications under Section 1(a) of the Trademark Act the party alleging fame must show that the mark had become famous prior to the applicant’s use of the mark,

Opposer desires to amplify its dilution pleading to specifically indicate that its SHARP marks were famous before any use by Applicant.

The proposed amendment allows the Opposer to argue facts in its Notice of Opposition that more fully support its claims of Likelihood of Confusion and Dilution that are consistent with information available in the online records of the USPTO and that can be substantiated with evidence that can be made of record.

(B) Applicant will not be Prejudiced by this Amendment

The trial period for this proceeding has not yet commenced. Neither side has taken any testimony at this point. No discovery depositions have taken place yet. Applicant's initial discovery responses are inadequate.

Any perceived prejudice to Applicant as a result of the proposed amendment can be alleviated by reopening and extending the discovery period (indeed Opposer has a pending motion to extend the discovery period). See e.g., *Focus 21 International, Inc. v. Pola Kasei Kogyo Kabushiki Kaisha*, 22 USP12d 1316, 1318 (TTAB 1992) (Board granted motion to amend notice of opposition prior to opening of petitioner's testimony period); *Space Base, Inc. v. Stadis Corp.*, 17 USPQ2d 1216 (TTAB 1990) (Motion to amend notice of opposition during Opposer's testimony period granted in part because any prejudice could be mitigated by reopening discovery solely for applicant); *Caron Corp. v. Helena Rubenstein, Inc.*, 193 USPQ 113 (TTAB 1976) (neither party had taken testimony); *Anheuser-Busch, Inc. v. Martinez*, 185 USPQ 434 9TTAB 1987) (granted where proceeding trial period had not commenced); *Cool-Ray, Inc. v. Eye Care, Inc.*, 183 USPQ 618 (TTAB 1987) (same). In this case, additional discovery is anticipated by both parties.

Opposer's new claim and revised allegations are essentially an amplification of the same information in Opposer's original Notice of Opposition with added detail added about its additional registrations. The amendment does not propose any radical new theories of the case nor do the alleged facts significantly change. See *Avedis Zildjian Co. v. D.H. Baldwin Co.*, 180 USPQ 539 (TTAB 1973) (allegations amplified). Accordingly, Opposer's proposed amendment of the notice of opposition will not cause any appreciable prejudice to Applicant. In view of this and that the interest of justice supports proceedings to hear all relevant claims, this motion should be permitted by the Board in this case.

Moreover, this motion was not brought in bad faith. Opposer is not attempting to make changes on the eve of trial. Rather, Opposer is acting conscientiously to conform the current pleadings to its newly appreciated evidence.

III. CONCLUSION

This motion to amend is presented in good faith with good cause, was not unduly delayed, and unduly prejudices no one. Consistent with the directive of Fed.R.Civ.P. 15(a) that such leave be freely given, Opposer requests that this motion be granted.

Respectfully submitted,

**SHARP KABUSHIKI KAISHA,
a/t/a SHARP CORPORATION**

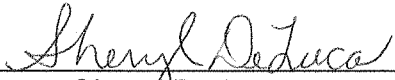
By: 

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CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing "OPPOSER'S MOTION FOR LEAVE TO AMEND NOTICE OF OPPOSITION" was this 6th day of October 2011 transmitted by first class mail to counsel for Applicant:

Donika P. Pentcheva
Westman Champlin & Kelly PA
900 Second Avenue South, Suite 1400
Minneapolis, MN 55402



Sheryl De Luca

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

SHARP KABUSHIKI KAISHA, a/t/a)	Attorney Ref.: 790-2052
SHARP CORPORATION,)	
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Opposer,)	
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v.)	Opposition No. 91190899
)	Mark: ONSHARP
ONSHARP, INC.,)	Application No. 77/645,273
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Applicant.)	

EXHIBIT A

TO

OPPOSER'S MOTION FOR LEAVE TO AMEND NOTICE OF OPPOSITION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Application Serial No. 77/645273 Published in the <i>Official Trademark Gazette</i> on May 5, 2009	
SHARP KABUSHIKI KAISHA, a/t/a SHARP CORPORATION, Opposer, v. ONSHARP, INC. Applicant.	Opposition No. 91190899
AMENDED NOTICE OF OPPOSITION	

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

In the matter of an application for registration of the mark ONSHARP, Serial No. 77/645,273, filed January 7, 2009, for "Marketing services, namely, providing informational web pages designed to generate sales traffic via hyperlinks to other web sites; On-line advertising and marketing services; Pay per click (PPC) advertising management services," in International Class 35 and "Computer services, namely, monitoring and reporting on the performance, availability, and errors of web sites of others; Computer services, namely, creating and maintaining web sites for others; Computer services, namely, designing and implementing web sites for others; Computer services, namely, managing web sites for others; Computer services, namely, monitoring the web sites of others to improve scalability and performance of web sites of others; Computer services, namely, search engine optimization; Consultation services in the field

of search engine optimization; Creating, designing and maintaining web sites; Creation and maintenance of web sites for others; Design and development of on-line computer software systems; Design of home pages, computer software and web sites; Design, creation, hosting, maintenance of web sites for others; Designing web sites for advertising purposes; Displaying the web sites and images of others on a computer server; Elaboration and maintenance of web sites for third parties; Hosting the web sites of others; Hosting the web sites of others on a computer server for a global computer network; IT consulting services; Web site design; Web site development for others; Web site hosting services," in International Class 42 by Onsharp, Inc. (hereafter "Applicant"), which was published in the Official Gazette dated May 5, 2009, Sharp Kabushiki Kaisha, a/t/a Sharp Corporation, a corporation of Japan and having a principal place of business located at 22-22 Nagaike-cho, Abeno-ku, Osaka 545-8522, Japan (hereafter "Opposer"), believes that it will be damaged by the registration of the mark shown in the above-identified application and hereby opposes same under the provisions of Section 13 of the Trademark Act of July 5, 1945 (15 U.S.C. §1063).

As grounds of opposition, Opposer alleges that:

1. Opposer is the owner of the entire right, title and interest to the mark SHARP as well as a "family" of related SHARP marks including, inter alia, BE SHARP, SHARPVISION & Design and SHARP PARTNER PROGRAM as used in connection with the sale of an extremely wide variety of computer products and related services. Since its initial use many years ago, Opposer has continuously sold such products and offered such services under the mark SHARP and the "family" of related SHARP marks

in virtually all channels of trade (including retail and online channels of trade) in the United States.

2. By virtue of its long, exclusive and continuous usage of the SHARP mark and the "family" of SHARP marks, Opposer has acquired and is the sole owner of substantial common law trademark and service mark rights with respect to those goods and services, as well as related goods and services. Furthermore, due to the very extensive nature of the sale and advertisement of these SHARP services and products, Opposer's SHARP mark and its related SHARP family of marks have become famous within the United States and throughout the world to both actual and potential customers before applicant's alleged use of the mark ONSHARP. In other words, the SHARP mark is an internationally famous mark that is well known not only in the United States but also all over the world with respect to electrical, electronic and audio-video products and related services for use by businesses and individuals. A significant indicia of the international fame of the SHARP marks is the fact that sales of SHARP brand products ranked 17th in the broad field of electronics and electrical equipment based upon worldwide sales (as ranked by Fortune magazine). Likewise, the SHARP mark has been legally recognized as famous in various countries throughout the world.

3. In addition to its substantial common law rights, Opposer is the exclusive owner, inter alia, of the following federal registrations directed to the SHARP family of marks:

- 1) Registration No. 1,093,113 for the mark SHARP, issued June 13, 1978.

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Applicant: Interactive Supercomputing, Inc.
Mark: ONSHARP
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- 2) Registration No. 1,405,542 for the mark SHARP, issued August 19, 1986, as used, for example, with computers.
- 3) Registration No. 1,985,630 for the mark SHARP issued July 9, 1996.
- 4) Registration No. 1,859,359 for the mark SHARP issued October 25, 1994.
- 5) Registration No. 1,725,154 for the mark SHARP issued October 20, 1992.
- 6) Registration No. 1,606,267 for the mark SHARPVISION & Design issued July 17, 1990.
- 7) Registration No. 1,526,673 for the mark SHARP issued February 28, 1989.
- 8) Registration No. 1,517,107 for the mark the mark SHARP CORPORATION issued December 20, 1988.
- 9) Registration No. 1,470,546 for the mark SHARP issued December 29, 1987.
- 10) Registration No. 1,120,410 for the mark SHARP issued June 19, 1979.
- 11) Registration No. 1,059,852 for the mark SHARP issued February 22, 1977.
- 12) Registration No. 877,692 for the mark SHARP issued September 30, 1969.
- 13) Registration No. 842,768 for the mark SHARP issued January 23, 1968.
- 14) Registration No. 2,887,128 for the mark SHARP issued September 21, 2004.
- 15) Registration No. 2,350,486 for the mark SHARP issued May 16, 2000.
- 16) Registration No. 2,207,058 for the mark SHARP issued December 1, 1998.
- 17) Registration No. 2,297,620 for the mark SHARP issued December 7, 1999.

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Applicant: Interactive Supercomputing, Inc.
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- 18) Registration No. 3,114,549 for the mark BE SHARP issued July 11, 2006 as used with maintenance and repair services for, inter alia, computers, computer software and computer peripheral devices.
- 19) Registration No. 3,564,815 for the mark SHARP & Design issued January 20, 2009, as used with, inter alia, computer servers, personal computer servers, and computer software for a wide variety of applications.
- 20) Registration No. 3,490,701 for the mark SHARP PARTNER PROGRAM issued on August 19, 2008, as used with computer programming and computer software design, maintenance and updating for others; consultancy and providing information in the field of computer software.
- 21) Registration No. 2,765,106 for the mark SHARP issued on September 16, 2003, as used with computer software for managing documents
- 22) Registration No. 2,756,747 for the mark SHARPDESK issued on August 26, 2003 for computer software for managing documents

Moreover, Opposer is the owner of pending trademark applications directed to the SHARP mark and/or the SHARP "family" of marks.

4. Upon information and belief, Applicant knew or should have known of Opposer's long prior use and registration of its SHARP mark and "family" of SHARP marks covering a wide variety of electrical, electronic and audio-video products and related services. These goods and services include, *inter alia*, (i) on-line marketing and advertising of SHARP products, (ii) computer software for a wide variety of SHARP electronic products, (iii) the design, development and sale of computer software systems, and (iv) IT consulting services.

5. Upon information and belief, the services that are proposed to be provided by Applicant under the mark ONSHARP and the services offered by Opposer under the SHARP mark and the SHARP "family" of marks are closely "related" since, inter alia, they are identical or very similar and/or they are purchased by the same customers. For

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Applicant: Interactive Supercomputing, Inc.
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example, Applicant's "on-line advertising and marketing services," "design and development of on-line computer software systems," "computer software," and "IT consulting services," overlap with products and services offered by Opposer under the SHARP mark and the SHARP "family" of marks, such as: 1) Reg. No. 3,114,549 for the mark BE SHARP as used with maintenance and repair services for, *inter alia*, computers, computer software and computer peripheral devices; 2) Reg. No. No. 3,564,815 for the mark SHARP & Design as used with, *inter alia*, computer servers, personal computer servers, and computer software for a wide variety of applications; and 3) Reg. No. 3,490,701 for the mark SHARP PARTNER PROGRAM as used with computer programming and computer software design, maintenance and updating for others; consultancy and providing information in the field of computer software. For this reason, the same types of persons who purchase and/or use Opposer's services are also likely to purchase and/or use Applicants' services.

6. The mark ONSHARP which Applicant now seeks to register is confusingly similar to Opposer's famous SHARP mark and similar to the SHARP "family" of marks. In addition, upon information and belief, the "ON" portion of Applicant's mark is merely generic or descriptive because it stands for "on-line." As a result, the registration and use of the ONSHARP mark by Applicant will result in trademark infringement.

7. Significantly, the dominant portion of Applicant's proposed mark is "Sharp" which is identical to Opposer's famous mark. Accordingly, Applicant's mark enhances both the likelihood of confusion and dilution.

8. In view of the foregoing, the registration of the mark ONSHARP by Applicant

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is likely to injure and/or dilute the strength and distinctive quality of Opposer's aforesaid trademarks and its related goodwill.

9. In addition, the registration of the ONSHARP mark in connection with services in International Classes 35 and 42, is likely to cause the purchasing public to erroneously assume that Applicant's services are related to, sponsored by or otherwise connection with Opposer, or vice versa.

WHEREFORE, Opposer requests that this opposition be sustained in all respects and, further, that the application of Applicant be refused registration.

Dated: October 6, 2011

Respectfully submitted,

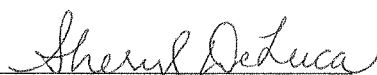
SHARP KABUSHIKI KAISHA, a/t/a
SHARP CORPORATION

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Certificate of Transmittal: I hereby certify that this correspondence is being electronically transmitted in PDF format to the Trademark Trial and Appeal Board through the Electronic System for Trademark Trials and Appeals (ESTTA) on the date indicated below:

Opposer: Sharp Kabushiki Kaisha, a/t/a Sharp Corporation
Applicant: Interactive Supercomputing, Inc.
Mark: ONSHARP
Serial No.: 77/645,273

Date: October 6, 2011


Sheryl De Luca